

REMARKS

This communication is a full and timely response to the aforementioned non-final Office Action dated March 15, 2006. By this communication, the Specification and claims 1-16 have been amended for clarity. Claims 1-16 are pending.

Claim Objections

Claim 1 was objected to because of alleged informalities. Applicants respectfully traverse this objection. However, in an effort to expedite prosecution, claim 1 has been amended to address the Examiner's concerns. Applicants request that the objection of claim 1 be withdrawn.

Rejections Under 35 U.S.C. §112

Claims 1-13 were rejected under 35 U.S.C. §112, second paragraph, as indefinite. Applicants respectfully traverse this rejection. However, in an effort to expedite prosecution claims 1-13 have been amended to address the Examiner's concerns. Applicants request that the rejections of these claims under 35 U.S.C. §112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 1-16 were rejected under 35 U.S.C. §103(a) as unpatentable over *Utsunomiya* (U.S. Patent No. 6,999,186) in view of *Terajima* (U.S. Patent No. 5,309,251). Applicants respectfully traverse this rejection.

Independent claims 1, 8, and 14 recite a detection unit that detects whether or not an expansion memory has been mounted to said mounting unit.

Utsunomiya discloses a multi-copy printing apparatus and method where print data sent from a host computer 1000 is stored in an input/output buffer 1032 via an input/output unit 3000. When data analysis begins, print data is read from the input/output buffer 1032,

analyzed, and sent to an image generation module 3002 to generate rasterized image data 3009. The generated image data is stored in a rasterized image storage area 3008 on a RAM 1037. Further, *Utsunomiya* discloses two methods that can be used to print a plurality of copies. In the first method, print data 3007 for one job is stored in the input/output buffer 1032, the data is read out from the input/output buffer 1032, and an image is produced or output based on the number of copies to be printed. In the second method, rasterized image data stored in the rasterized image storage area 3008 is read out and output in a process that is repeated in correspondence with the number of copies to be printed.

The Examiner acknowledges that *Utsunomiya* fails to teach or suggest a detection unit and a controller as recited in claims 1, 8, and 14, and relies on *Terajima* to remedy these deficiencies.

Terajima discloses a facsimile apparatus that has a sensor to detect the presence of an external memory 109. A sensor 119 notifies a control unit 101 whether an external memory 109 is connected to the control unit 101. During operation, if a CPU 113 detects the presence of the external memory 109, the CPU copies the communication result located in a temporary buffer of a RAM 115 into the external memory 109 to complete the communication. The communication result is stored in the external memory 109 and includes information, such as, the telephone number and name of the communication partner, ID information start time, communication time, number of sheets, the communication result, and the charge. In other words, the communication result is not image data but rather data that includes information related to the transaction between two fax machines. Based on these teachings, there is no indication that the features *Terajima* can be substituted or integrated into the system of *Utsunomiya* and achieve the claimed results. To reach any conclusion otherwise would require an improper reliance on Applicants' own disclosure.

In summary, *Utsunomiya* and *Terajima*, either singularly or combined, fail to teach or suggest every element recited in independent claims 1, 8, and 14. In particular, the combined references fail to teach or suggest a detection unit as recited in the aforementioned claims. Accordingly, a *prima facie* case of obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the above reasons, Applicants request that the rejection of claims 1, 8, and 14 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Claims 2-7 depend from claim 1, claims 9-13 depend from claim 8, and claims 15 and 16 depend from claim 14. By virtue of these dependencies, Applicants submit that these claims are allowable for at least the same reasons given above with regard to their respective base claim. In addition, Applicants submit that these claims are further distinguishable over *Utsunomiya* and *Terajima* by the additional elements recited therein. Applicants request, therefore, that the rejection of claims 2-7, 9-13, 15, and 16 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants submit that claims 1-16 are allowable, and this application is in condition for allowance. In the event the instant application can be placed in even better form, Applicants request that the undersigned attorney be contacted at the number below.

Respectfully submitted,

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